REMARKS

Claims 1-24 were pending in this application.

Claims 1-24 have been rejected.

No claims have been amended.

Claims 1-24 remain pending in this application.

Reconsideration and full allowance of Claims 1-24 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art ("*APA*") in view of U.S. Patent No. 6,292,187 to Gibbs et al. ("*Gibbs*"). The Office Action rejects Claims 20-24 under 35 U.S.C. § 103(a) as being unpatentable over *APA* and *Gibbs* in further view of U.S. Patent No. 5,751,962 to Fanshier et al. ("*Fanshier*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re*

Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does

not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re*

Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself

suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781,*

783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or

suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the

reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. (*MPEP § 2142*).

Both *APA* and *Gibbs* fail to disclose, teach, or suggest bi-directional control between a

"digital audio playback device" and a "processing system." More specifically, both *APA* and *Gibbs*

fail to disclose, teach, or suggest any type of application programming interface (API) that allows a

digital audio playback device to control a "user interface" associated with a processing system

(where the processing system also controls the digital audio playback device) as recited in Claims 1,

7, 13, and 20.

APA simply recites that a processing system (such as a PC) controls a digital audio playback

device. For example, a user interface on the PC may use an API on the digital audio playback device to control the digital audio playback device. (*Application, Page 2, Lines 4-11; Page 4, Lines 8-17*). *APA* lacks any mention of bi-directional control in this setup. More specifically, *APA* lacks any mention that the digital audio playback device is controlled by the PC and that the digital audio playback device controls the user interface of the PC. Also, *APA* lacks any mention of using the API on the digital audio playback device to control the user interface on the PC.

In addition, the Office Action incorrectly asserts that page 4, lines 12-15 of *APA* discloses a "reverse DAPD API" as recited in Claims 1, 7, 13, and 20. This portion of *APA* simply recites that an API is supported by the digital audio playback device. The API allows the PC to access and control the digital audio playback device. At most, this portion of *APA* simply discloses the use of an API on a digital audio playback device that is used to control the digital audio playback device. This portion of *APA* says nothing about a "reverse DAPD API" that is used to control a user interface on the PC of *APA*.

Gibbs recites a system of uni-directional control between a network and an intelligent device. (*Abstract*). The intelligent device provides a user interface to users that is controlled by a set of "mattes." (*Abstract*). The mattes control the ways in which components in the user interface are displayed. (*Abstract*). APIs are supported by and reside in the intelligent device. (*Col. 7, Lines 28-39*).

In *Gibbs*, one or more APIs are used to allow an external network to access the intelligent device and provide the mattes. As with *APA*, there is no form of bi-directional control between the network and the intelligent device in *Gibbs*.

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Moreover, Claims 1, 7, 13, and 20 specifically recite that the "reverse DAPD API" is used to allow a digital audio playback device to control a "user interface" associated with a processing system. The APIs in *Gibbs* reside on the intelligent device and are used to alter the appearance of an interface on that device. In other words, *Gibbs* simply recites that an API may be used to control some operation on the same device that provides the API. *Gibbs* lacks any mention of using an API to allow one device or system to control a user interface on another device or system.

For these reasons, the proposed *APA-Gibbs* combination fails to disclose, teach, or suggest all elements of Claims 1, 7, and 13. For similar reasons, the proposed *APA-Gibbs-Fanshier* combination fails to disclose, teach, or suggest all elements of Claim 20. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claims 1, 7, 13, and 20 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-24.

II.   CONCLUSION

The Applicant respectfully asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _Aug 3, 2005_

William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*